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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,480	04/19/2004	Cassandre Michelle Fecht	DC4998CIP1	3304

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Dow Corning Corporation
Intellectual Property Dept. - CO1232
P.O. Box 994
Midland, MI 48686-0994

EXAMINER	
ROBERTS, LEZAH	
ART UNIT	PAPER NUMBER
1612	

MAIL DATE	DELIVERY MODE
09/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/827,480	FECHT ET AL.	
	Examiner	Art Unit	
	LEZAH W. ROBERTS	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 2, 4-7, 9, 11 and 12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 2, 4-7, 9, 11 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicants' arguments in the Appeal Brief, filed May 18, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims

Claim Rejections - 35 USC § 103 – Obviousness (New Rejections)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1) Claims 1, 2, 5-7, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candau (US 6,033,648).

Candau discloses tanning compositions comprising iron oxide nano-pigments (see Abstract), encompassing claims 9 and 11. The compositions also comprise a silicone emulsifier encompassing the hydrocarbyl functional organopolysiloxane compounds of the instant claims (col. 6, lines 39-62). These are preferred emulsifiers. The R groups of (II) of the reference encompass R^1 of the instant claims where R^1 is $-(CH_2)_3OCH_2CH_2OH$. The R group of the reference is $-(CH_2)_sO-(C_2H_4O)_t(C_3H_6O)_uR^1$ where s is 1 to 5, t is 1 to 100, u is 0 to 50 and R^1 is H, CH_3 or CH_2CH_3. These values encompass the corresponding group of the instant claims. The repeating silicone unit of the referenced structure ranges from 5 to 300, which encompasses the corresponding silicone unit of the instant claims having a repeating unit value of 1 to 500. The R^2 group of the reference is a C1-C3 alkyl or phenyl, encompassing the R group of the instant

claims, which may be an alkyl group or aryl group containing 1-20 carbon atoms. The compositions are cosmetics and additionally comprise conventional cosmetic and/or dermatological adjuvants (col. 10, lines 49-59). The reference differs from the instant claims insofar as it does not disclose the exact end points for the number of repeating units recited in the instant claims.

The prior art does not disclose the exact claimed values, but does overlap: in such instances even a slight overlap in range establishes a *prima facie* case of obviousness. In re Peterson, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). The reference discloses the R group of the reference is $-(CH_2)_sO-(C_2H_4O)_t(C_3H_6O)_uR^1$ where s is 1 to 5, t is 1 to 100, u is 0 to 50 and R^1 is H, CH_3 or CH_2CH_3, which corresponds to the R^1 group of the instant claims $(CH_2)_3OCH_2CH_2OH$ when s is 3, t is 1 and u is 0. The repeating silicone unit of the referenced structure ranges from 5 to 300 encompassing the corresponding silicone unit of the instant claims having a repeating unit value of 1 to 500. The R^2 group of the reference is a C1-C3 alkyl or phenyl, encompassing the R group of the instant claims, which may be an alkyl group or aryl group containing 1-20 carbon atoms. It would have been obvious for one of ordinary skill in the art to have used the compounds of the instant claims in the cosmetics of the reference consistent with the In re Peterson decision.

2) Claims 1, 2, 5-7, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemann et al. (US 6,541,017).

Lemann et al. disclose cosmetic compositions comprising at least one silicone oil and at least one pigment (see Abstract), encompassing claims 9 and 11. The compositions may be formulated into lipsticks (col. 7, lines 4-9). The compositions comprise olyalkylenated silicones (col. 23, lines 5-50). The R groups of structure in col. 3 encompass R^1 of the instant claims where R^1 is $-(CH_2)_3OCH_2CH_2OH$. The R groups of the reference may be $-(CH_2)_pO(C_2H_4O)_x(C_3H_6O)_yR^1$ where p is 1 to 5, x is 1 to 100, y is 0 to 50 and R^1 is H, CH_3 or CH_2CH_3. These values encompass the corresponding group of the instant claims. The repeating silicone unit of the referenced structure ranges from 5 to 300, which encompasses the corresponding silicone unit of the instant claims having a repeating unit value of 1 to 500. The R^2 group of the reference is a C1-C3 alkyl or phenyl, encompassing the R group of the instant claims, which may be an alkyl group or aryl group containing 1-20 carbon atoms (col. 3, lines 1-20.

The reference differs from the instant claims insofar as it does not disclose the exact end points for the number of repeating units recited in the instant claims.

The prior art does not disclose the exact claimed values, but does overlap: in such instances even a slight overlap in range establishes a *prima facie* case of obviousness. In re Peterson, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). The reference discloses the R group of the reference is $-(CH_2)_pO\text{-}(C_2H_4O)_x(C_3H_6O)_yR^1$ where p is 1 to 5, x is 1 to 100, y is 0 to 50 and R^1 is H, CH_3 or CH_2CH_3, which corresponds to the R^1 group of the instant claims $(CH_2)_3OCH_2CH_2OH$ when p is 3, x is 1 and y is 0. The repeating silicone unit of the referenced structure ranges from 5 to 300, which falls within the range of the corresponding silicone unit of the instant claims having a

repeating unit value of 1 to 500. The R^2 group of the reference is a C1-C3 alkyl or phenyl, encompassing the R group of the instant claims, which may be an alkyl group or aryl group containing 1-20 carbon atoms. It would have been obvious for one of ordinary skill in the art to have used the compounds of the instant claims in the cosmetics of the reference consistent with the In re Peterson decision.

Obvious-Type Double Patenting (New Rejection)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5-7, 9, 11 and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 6-13 of copending Application No. 10/592714 in view of Ferrari et al. (US

6,251,413). Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claims and the copending claims both encompass a cosmetic composition comprising a hydrocarbyl functional organopolysiloxane polymer having the same structures. Both sets of claims also recite that the compositions may be formulated into lipsticks. The instant specification discloses that the hydrocarbyl functional polymers may also be resins and the instant claims recite the compositions comprise at least one cosmetic ingredient. The instant claims differ from the copending claims insofar as they do not disclose an organopolysiloxane resin and the instant claims encompass formulas of hydrocarbyl functional organopolysiloxane polymers not recited by the copending claims.

Ferrari et al. disclose silicone resins are mixed with silicone oils to formulate cosmetic compositions such as lipstick (col. 9, lines 35-38). The reference differs from the instant claims insofar as it does not disclose the polymers of the hydrocarbyl functional organopolysiloxanes of the instant claims.

Generally, it is *prima facie* obvious to select a known material for incorporation into a composition, based on its recognized suitability for its intended use. See MPEP 2144.07. One of ordinary skill in the art would be motivated to add resins to the compositions of the instant claims motivated by the desire to use a component that may also act as the hydrocarbyl functional polymer of the instant claims as disclosed by the instant specification and is a cosmetic ingredient suitable for use in a lipstick as disclosed by Ferrari et al. and supported by MPEP 2144.07.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1, 2, 5-7, 9, 11 and 12 are rejected.

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEZAH W. ROBERTS whose telephone number is (571)272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lezah W Roberts/
Examiner, Art Unit 1612

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612